

In Claim 26, in line 3 replace "the" (first occurrence) with --a--.
In Claim 27, in line 3 replace "the" (first occurrence) with --a--.
In Claim 28, in line 1 replace "18" with --23--.
In Claim 29, in line 1 replace "18" with --23--.
In Claim 32, in line 3 replace "the" (first occurrence) with --a--.
In Claim 33, in line 2 replace "the distal" with --a distal end--.
In Claim 34, in line 3 replace "the" (first occurrence) with --a--.
In Claim 35, in line 1 replace "25" with --31--.
In Claim 36, in line 1 replace "25" with --31--.

Remarks:

In the Office Action of Paper No. 5 the specification was objected to and more specifically, the title was objected to for not being descriptive. The title has been amended herein to be more descriptive of the subject matter of the application.

The claims of the application were objected to for their sequence and more specifically, Claims 2, 3, 4, 5 and 6 were objected to as reciting the same subject matter as Claims 8, 9, 10, 11 and 12, respectively. The dependency of Claims 2 through 5 and 12 has been corrected by amendments made to the claims herein. With the amendments to the claims, Claims 2 through 6 all depend directly from Claim 1 and Claims 8 through 12 all depend directly from Claim 7.

The dependency of Claims 28 and 29 has also been amended herein so that these claims depend directly from independent Claim 23 and the dependency of Claims 35 and 36 has been amended herein so that these claims depend directly from independent Claim 31. With these amendments Claims 14 through 22 all depend from independent Claim 13, Claims 24 through 30 all depend from independent Claim 23 and Claims 32 through 40 all depend from independent Claim 31.

Claims 3 through 5, 9 through 11, 15 through 17, 26 through 28, 30 and 33 through 35 were rejected under 35 U.S.C. §112, second paragraph as being indefinite. With specific reference to Claims 3, 9, 15, 26 and 33, although no correction of the language of these claims was required despite their being rejected, it was pointed out that the term "flexible magnetic material" was a relative term. Applicant intends the phrase "flexible magnetic material" of the guide wire to have the same meaning as set forth in Claim 1, i.e., the guide wire being sufficiently flexible adjacent the magnet to allow the wire to flex in response to a magnetic field applied to the magnet. Thus, the "flexible magnetic material" is sufficiently flexible to allow it to flex in response to a magnetic field applied to the flexible magnetic material. This meaning

of "flexible magnetic material" is consistent with the understanding of the term "flexible" as used in the relevant art and as used in Claim 1 of the primary reference cited in the Office Action.

Claim 30 was rejected for its use of the word "stricture", supposing this to be a misspelling of "structure". However, the word is not misspelled and is intended to have its common dictionary definition of a restriction. Therefore, reciting the lumen of the medical device as having a stricture means that the lumen has a restriction that prevents the guide wire from passing through the lumen beyond the restriction.

Claims 4, 10, 16, 27 and 34 were rejected under the first paragraph of 35 U.S.C. §112 for their subject matter not being described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. However, the subject matter of these claims is fully described in the specification beginning on page 12, line 27 and continuing to page 13, line 29. The subject matter is also shown in Figures 12 and 12a of the application. There is no requirement that the specification contain an explanation as to why a claimed device is improved. However, this explanation is also included in the specification on page 13, in lines 12 through 29.

Claims 5, 11, 17, 28 and 35 were also rejected under 35 U.S.C. §112, first paragraph for reciting subject matter that was not described in the specification in a way to enable one skilled in the art to make and use the invention. Again, there is no requirement that the specification include an explanation of why a device is improved in order to enable the ordinary skilled artisan to make and use the invention. However, the specification contains repeated explanations of the desirability of using a permeable magnet, the first of these appearing on page 6, lines 31 through 36.

For the reasons discussed above, it is respectfully requested that the rejection of Claims 3 through 5, 9 through 11, 15 through 17, 26 through 28, 30 and 33 through 35 be withdrawn.

Claims 1 through 3, 6 through 9, 12 through 15, 18 through 26, 29 through 33 and 36 through 40 were rejected under 35 U.S.C. §102(b) as being anticipated by the U.S. Patent of Anderson No. 4,244,362. It is respectfully submitted that the subject matter of the invention recited in the above claims is not disclosed by the Anderson reference and therefore cannot be anticipated by that reference.

A party asserting that a patent claim is anticipated under 35 U.S.C. §102 must demonstrate, among other things, identity of invention. Kalman v. Kimberly-Clarke Corp., 713 F.2d 760, 218 USPQ 781, 789 (Fed. Cir. 1983).

For a prior art reference to anticipate, every element of the claimed invention must be identically shown in a single reference. In re Bond, 910 F.2d 831, 15 USPQ 2d 1566, 1567, 1568 (Fed. Cir. 1990).

[A]ny degree of physical difference, however slight, invalidates claims of anticipation. Ultradent Products, Inc. v. Life-Like Cosmetics, Inc., 39 USPQ 2d 1969, 1980 (Utah 1996).

Each of the independent claims of the application including apparatus Claims 1, 7 and 23 and method Claims 13 and 31 include the recitation of a "guide wire". The use of the word "wire" in the claims has its usual dictionary definition of metal in the form of a usually very flexible thread or slender rod. In contrast to this, the Anderson reference discloses a stylet 25 comprised of a coiled spring 25, 55. Thus, the Anderson reference does not demonstrate identity of invention nor does it identically show every element of the claimed invention as required by the above cited case law in order for the reference to anticipate the subject matter of the independent claims. Furthermore, as set forth above, any degree of physical difference, however slight, invalidates claims of anticipation. The coiled spring disclosed in the Anderson reference is physically different from the wire recited in the independent claims of the application and therefore the Anderson reference does not anticipate the subject matter of the independent claims.

Claims 2 through 6 all depend from independent Claim 1, Claims 8 through 12 all depend from independent Claim 7, Claims 14 through 22 all depend from independent Claim 13, Claims 24 through 30 all depend from independent Claim 23 and Claims 32 through 40 all depend from independent Claim 31 and for the reasons discussed above these dependent claims are also not anticipated by the Anderson reference.

X In addition to the above, Claims 2, 8 and 25 all describe the magnet having a cylindrical body and having an axial bore therethrough, and the distal end of the guide wire extending into the axial bore. The Anderson reference contains no disclosure of the connection

of the magnet and guide wire recited in these claims. For this additional reason, the claims are not anticipated by the Anderson reference.

* Claims 3, 9, 15, 26 and 33 all contain a description of the magnet on the distal end of the guide wire comprising a flexible magnetic material forming a distal end section of the guide wire. There is no disclosure of such a flexible magnetic material in the Anderson reference. For this additional reason, the Anderson reference does not anticipate the subject matter of these claims.

* Still further, Claims 20, 22, 38 and 40 all contain a description of a method step of advancing the guide wire by pulling the guide wire with a magnetic field. The Anderson reference contains no disclosure of such a method step. For this additional reason, the subject matter of these claims is not anticipated by the Anderson reference.

Claims 4, 5, 10, 11, 16, 17, 27, 28, 34 and 35 were also rejected under 35 U.S.C. §102(b) as being anticipated by the Anderson reference, or in the alternative being obvious under 35 U.S.C. §103(a) in view of the Anderson reference.

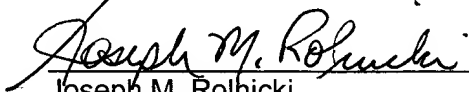
As set forth above, the Anderson reference fails to identically disclose the subject matter of the independent claims of the application and therefore also fails to identically disclose the subject matter of the dependent claims and does not anticipate the subject matter of the dependent claims. ~~The obviousness rejection made of the above claims cannot be understood~~ from the explanation provided in the Office Action. The Office Action appears to state that because the importance of spacing the magnets along the guide wire is not explained in the specification, then this particular limitations can be ignored and considered obvious without it being disclosed in the prior art. Such rejection fails to establish a prima facie case of obviousness. Furthermore, as set forth above in responding to the rejections under §112, the specification does explain the desirability of spacing the magnets along the guide wire. Because the Anderson reference fails to provide any suggestion of spacing magnets along a guide wire it fails to make obvious the subject matter of the aforesaid claims. For this additional

reason, the claims are allowable over the Anderson reference and the other prior art of record in the application.

The Office Action states that claims are rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of the U.S. Patent of Viera, No. 5,464,023, but does not identify what claims are considered to be obvious in view of these references. However, the Viera reference discloses a catheter that employs magnets for a completely different purpose than that of the invention. For example, the magnet of the invention in each embodiment is attached to the guide wire adjacent the distal end of the guide wire. In contrast, the Viera reference discloses magnets 16 that are connected to the opposite proximal end of a guide wire. Furthermore, the magnets 16 are mounted on a rigid rod and are not mounted on a flexible guide wire as are the magnets of the invention. The disclosure in the Viera reference is so fundamentally different from that of the invention that it cannot provide sufficient information to the ordinary skilled artisan to render obvious the subject matter of the claims pending in the application whether combined with the Anderson reference or not. For the reasons set forth above, Claims 1 through 40 presently pending in the application are not obvious in view of the combined teachings of Anderson and Viera and are allowable over these references and the remaining prior art of record in the application.

~~In view of the amendments and remarks presented above, it is respectfully~~
submitted that the application is in condition for allowance and favorable action is requested.

Respectfully submitted,



Joseph M. Rolhicki
Reg. No. 32,653
Howell & Haferkamp, L.C.
7733 Forsyth Boulevard, Suite 1400
St. Louis, Missouri 63105
(314) 727-5188